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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/660,233	09/10/2003	John M. Keating	P-1616-031	7718
7590	10/18/2004			
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			EXAMINER	
			BLAU, STEPHEN LUTHER	
		ART UNIT	PAPER NUMBER	
		3711		

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/660,233

Applicant(s)

KEATING, JOHN M.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/10/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The reply filed on 12 August 2004 is in compliance with 37 CFR 1.121 in that the status of every claim must be indicated after its claim number by using a claim identifier in a parenthetical expression. In the response the canceled claims do not have a claim identifier in a parenthetical expression after the claim number. Future amendments must include this to be considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 7 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may" in lines 5 and 8 in claim 11 are indefinite in that it is uncertain whether the limitation being referred to is required or not. Claim 11 is indefinite in that the terms "equivalent materials" is indefinite. Claim 13 is indefinite in that in lines 4-5 it is uncertain what the statement "proximal the apparatus first end being greater than the grip clip second end dimension D2" means. In addition, claim 13 is indefinite in that the terms "other forms" and "other similar" are indefinite. It

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is uncertain what the limit of this claim is to these elements of structure. Claim 14 is indefinite in that the statement "the apparatus at the clip slot will receive either the apparatus shaft to slide up the apparatus shaft toward the apparatus first end". Claim 7 is indefinite in that throughout the claim it appears that the putter shaft is being referred to as reference number 10 which is the apparatus shaft. In addition in claim 7 there are reference numbers without parentheses.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Foresi.

Foresi discloses a putter apparatus having an upper shaft (30) with a counter weight in the form of a grip (33) proximal to an end (Fig. 5), and a grip clip means in the form of a clamp affixed with a hinge means at an apparatus upper shaft second end (Fig. 8).

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith.

Smith discloses a club apparatus able to be used for a putter having an upper shaft with a counter weight in the form of a grip proximal to an end (Fig. 1), and a grip clip means in the form of a clamp affixed with a hinge means at an apparatus upper shaft second end (Figs. 1-2).

7. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Schuster.

Schuster discloses a putter apparatus having an upper shaft (4) with a counter weight in the form of a pad (8) proximal to an end (Fig. 1), and a grip clip means in the form of a clamp (12) affixed with a hinge means at an apparatus upper shaft second end (Figs. 1-2).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannon.

Smith lacks a putter shaft, a putter grip having a dimension greater than a lower shaft dimension of the putter, and an apparatus upper shaft and a putter lower shaft being tubular. Hannon discloses a club being a putter (Title), and a putter grip having a dimension greater than a metal hollow shaft (Col. 2, Lns. 43-48) dimension of the putter (Fig. 1). In view of the patent of Hannon it would have been obvious to modify the apparatus and club of Smith to include a putter in order to utilize the advantages of having two handles for swinging a club for a putter club. In view of the patent of Hannon it would have been obvious to modify the apparatus and club of Smith to have a putter grip having a dimension greater than a lower shaft dimension of the putter shaft in order to simplify the manufacturing of a putter shaft by having the shaft cylindrical or slightly tapered and placing the grip about the surface as opposed to changing the surface of the putter shaft to receive a grip. In view of the patent of Hannon it would have been obvious to modify the apparatus and club of Smith to have an apparatus shaft and a putter shaft being metallic and hollow in order to minimize weight and/or material for an apparatus and putter shaft and in order to utilize the advantages of a two handle club for hollow metallic shaft clubs and hollow shaft handles.

10. Claims 5, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannon as applied to claims 9-10 above, and further in view of Foresi, Tucker and Cline.

Smith lacks a clip slot, a slot dimension being greater than the putter shaft dimension near the head, a slot dimension be less than the putter grip dimension, and a clip tapering from one end to the other.

Foresi discloses an apparatus which has a clamp with has a slot for affixing to a putter shaft (Fig. 8). In view of the patent of Foresi it would have been obvious to modify the apparatus of Smith to have a clamp with a slot in order to use less material for a clamp.

Tucker discloses a clamp/clip with a slot where the slot dimension is greater than the putter shaft dimension near the head and the slot dimension be less than the putter grip dimension in order to fit the clamp on at the small diameter end of a shaft (Col. 2, Lns. 55-60). In view of the patent of Tucker it would have been obvious to modify the apparatus of Smith to have a slot dimension being greater than the putter shaft dimension near the head and a slot dimension be less than the putter grip dimension in order to allow fitting the clamp on at a small diameter end of a shaft yet prevent the apparatus from inadvertently slipping off the butt end of the grip.

Cline discloses a clamp/clip for a shaft tapering from one end to the other in order to have a snug fit with a shaft which is tapered (Col. 3, Lns. 41-55). In view of the patent of Cline it would have been obvious to modify the clamp of Smith to have a clip tapering from one end to the other in order to have a snug fit with a shaft and grip with is tapering.

11. Claims 5 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sosin in view of Foresi, Smith, Hannon, Tucker and Cline.

Sosin discloses a method of putting by positioning an upper end of a shaft in contact with a golfer's neck and retaining the upper shaft in contact with a golfer's neck through out the stroke (claim 1).

Sosin lacks an apparatus upper shaft, a counter weight at a first end of the upper shaft, a grip clip means hinged at an apparatus upper shaft second end, an apparatus upper shaft and a putter lower shaft being tubular, a clip attached to a grip, a hinge as defined by the claims, a clip slot, a slot dimension being greater than the putter shaft dimension near the head, a slot dimension be less than the putter grip dimension, and a clip tapering from one end to the other.

Foresi discloses a long putter with one long shaft (Fig. 1) or an apparatus upper shaft, a counter weight at an first end of the upper shaft (Fig. 3), a grip clip means hinged at an apparatus upper shaft second end (Fig. 8) and an apparatus which has a clamp with has a slot for affixing to a putter shaft (Fig. 8) in order to be able to adjust the upper shaft and in order to add an upper shaft to a preexisting normal length shaft (abstract). In view of the patent of Foresi it would have been obvious to modify the putter of Sosin to have a an apparatus upper shaft, a counter weight at a first end of the upper shaft, and a grip clip means with a slot and hinged at an apparatus upper shaft second end in order to be able to adjust the upper shaft and in order to add an upper shaft to a preexisting normal length shaft which will have a padding to comfort the neck area when using a putter.



Smith discloses a hinge as defined by the claims (Fig. 1) and affixing the clip to a grip (Fig. 1). In view of the patent of Smith it would have been obvious to modify the apparatus of Sosin to have a hinge as defined by the claims in order to have a hinge which only allows movement in one plane. In view of the patent of Smith it would have been obvious to attach the apparatus to the bottom of the grip instead of the shaft below the grip in order to minimize the length of the apparatus needed to be in contact with the neck.

Hannon discloses a putter having a metal hollow shaft (Col. 2, Lns. 43-48). In view of the patent of Hannon it would have been obvious to modify the apparatus and club of Sosin to have an apparatus shaft and a putter shaft being metallic and hollow in order to minimize weight and/or material for an apparatus and putter shaft and in order to utilize the advantages of a two handle club for hollow metallic shaft clubs and hollow shaft handles.

Tucker discloses a clamp/clip with a slot where the slot dimension is greater than the putter shaft dimension near the head and the slot dimension be less than the putter grip dimension in order to fit the clamp on at the small diameter end of a shaft (Col. 2, Lns. 55-60). In view of the patent of Tucker it would have been obvious to modify the apparatus of Sosin to have a slot dimension being greater than the putter shaft dimension near the head and a slot dimension be less than the putter grip dimension in order to allow fitting the clamp on at a small diameter end of a shaft yet prevent the apparatus from inadvertently slipping off the butt end of the grip.

Cline discloses a clamp/clip for a shaft tapering from one end to the other in order to have a snug fit with a shaft which is tapered (Col. 3, Lns. 41-55). In view of the patent of Cline it would have been obvious to modify the clamp of Sosin to have a clip tapering from one end to the other in order to have a snug fit with a shaft and grip with is tapering.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 14 October 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**